

REMARKS

Applicants wish to thank the Examiner for the careful consideration given this case. Claims 2-14 are pending in this case. Applicants request that the Examiner reconsider the rejections in view of the amendments the remarks presented herein. This response addresses those issues raised in the Office Action mailed on January 17, 2003. It is submitted that, as currently amended, the claims are in condition for allowance. Communication to this effect is respectfully requested.

The Examiner rejects Claims 1-13 as being indefinite under 35 U.S.C. § 112. Claim 1 has been cancelled, but Claim 14 has been newly presented herein in place thereof. New Claim 14 and amended Claim 7 address the Examiner's concerns. It is respectfully submitted that Claim 3 does limit Claim 14 insofar as the specific location of the reagent is recited. Claim 10 is fully supported by the specification at Page 10, lines 12-18 and is definite. Reconsideration and withdrawal of these rejections is respectfully requested.

Statement of common ownership

The Examiner provisionally rejects Claims 1-13 under the doctrine of obviousness-type double patenting as being unpatentable over Claims 1-5 of co-pending Application No. 09/858,392. **The two applications were, at the time the later invention was made, owned by, or subject to an obligation of assignment to, Fuji Photo Film, Co. LTD.** A terminal disclaimer is being filed herewith to address this rejection.

The Examiner further provisionally rejects Claims 7-13 under the doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending Application No. 09/978,142. It is respectfully submitted that the co-pending application is directed to an improvement in conventional dry analytical elements that have a spreading layer. In light of the present amendments, it is respectfully submitted that the pending claims are distinct from the claimed subject matter of 09/978,142. Reconsideration and withdrawal of this rejection is respectfully requested.

The Examiner rejects Claims 1-3, 6-10, and 13 as being unpatentable under 35 U.S.C. § 102(b) as anticipated by JP 356097872A, Sheehy (US 5,548,712), Neyer (US 5,725,774), or Sakamoto et al. The Examiner asserts that the cited references all teach a dry analytical element having an impermeable layer and hydrophilic layer. However, the claims as presently amended are clearly distinguishable and patentable over the cited references as explained further below.

The dry analytical elements of the present invention are characterized by the absence of a spreading layer, as the claim language "consisting essentially of" indicates. The principal function of a spreading layer of the cited references is to spread the components contained in a sample with roughly constant rate per unit area without substantially uneven distribution, as stated on page 2, line 23 to page 3, line 1 of the present application. This functionality is replaced by the water impermeable frame body or the mesh layer and compartment(s) with a hydrophilic bottom of the present invention.

In contrast, JP '782 discloses a traditional dry analytical element having a spreading layer (*See Abstract*). JP '782 does not teach the use of

compartment(s) with a hydrophilic bottom as described and claimed in the present invention.

Sheehy discloses a microsphere for immunoassay (col. 4, line 21) having metallic islands on its surface covered with a layer of coupling agent, as shown in Figs. 1-3. As is clear through the detailed description of the specification, Sheehy does not disclose a dry analytical element as described and claimed in the present invention.

Neyer concerns a whole blood separation device, and discloses two such devices in Figures 1 and 2. However, Neyer does not teach compartment(s) having a hydrophilic bottom, as presently claimed.

Sakamoto discloses a traditional dry analytical element having a spreading layer (col. 3, line 32) which is indicated by 10c (col. 4, line 41). Sakamoto does not teach the use of compartment(s) with a hydrophilic bottom as described and claimed in the present invention.

As is clear, each of the cited references is distinguishable over the presently-pending claims of the current application in that they do not contain each and every claim limitation. A claim is anticipated by a prior art reference if, and only if, each and every claim limitation may be found, either expressly or inherently described, in a single prior art reference. MPEP § 2131.01. It is respectfully submitted that the cited references do not satisfy this requirement. Accordingly, the rejections under § 102 are inappropriate. Reconsideration and withdrawal of these rejections is respectfully requested.

The Examiner rejects Claims 7-10 and 13 as being unpatentable under 35 U.S.C. § 102(b) as anticipated by Mori et al. The Examiner states that

Applicants' claim language does not exclude the presence of additional elements, such as a spreading layer, that is taught by Mori et al. The present claims have been amended to address this concern of the Examiner. In addition, Mori discloses a traditional dry analytical element having a spreading layer (col. 1, line 62). Mori does not teach the use of compartment(s) with a hydrophilic bottom as described and claimed in the present invention. Therefore, it is respectfully submitted that the claims as presently amended are patentably distinguishable over Mori et al. Reconsideration and withdrawal of this rejection is respectfully requested.

Applicants note the Examiner's comments regarding joint inventors. The inventorship of the present application is confirmed as appropriate.

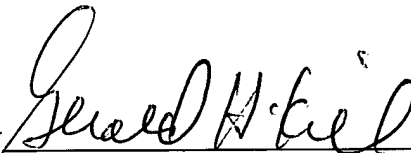
The Examiner rejects Claims 4-5 and 11-12 under 35 U.S.C. § 103(a) as being obvious in light of JP 356097872A, Sheehy (US 5,548,712), Neyer (US 5,725,774), or Sakamoto et al. It is respectfully submitted that, as herein amended, the present claims are not obvious in light of the cited art. In particular, none of the cited references teach or suggest the dry analytical elements of the present invention having a compartment with a hydrophilic bottom, as recited in Claim 14. Claim 7 recites a dry analytical element with a mesh layer – a limitation that is not taught or suggested by the cited references. As the Examiner is aware, to establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested in the prior art. MPEP § 2143.01. It is submitted that the cited references do not satisfy this requirement for the claims as presently amended. Reconsideration and withdrawal of this rejection is respectfully requested.

In view of the amendments to the claims and the remarks presented herein, it is respectfully submitted that the present application is in condition for final allowance and notice to such effect is requested. If the Examiner believes that additional issues need to be resolved before this application can be passed to issue, the undersigned invites the Examiner to contact him at the telephone number provided below.

Respectfully submitted,

Dated: June 17, 2003

By



Gerald H. Kiel, Reg. No. 25,116 for
Jules E. Goldberg, Reg. No. 24,408

REED SMITH LLP
599 Lexington Avenue
New York, NY 10022
(212) 521-5403

Attorney for Applicant